

Attorney Docket No. LWEP:121US  
U.S. Patent Application No. 10/735,394  
Reply to Office Action of November 28, 2006  
Date: February 28, 2007

**Remarks**

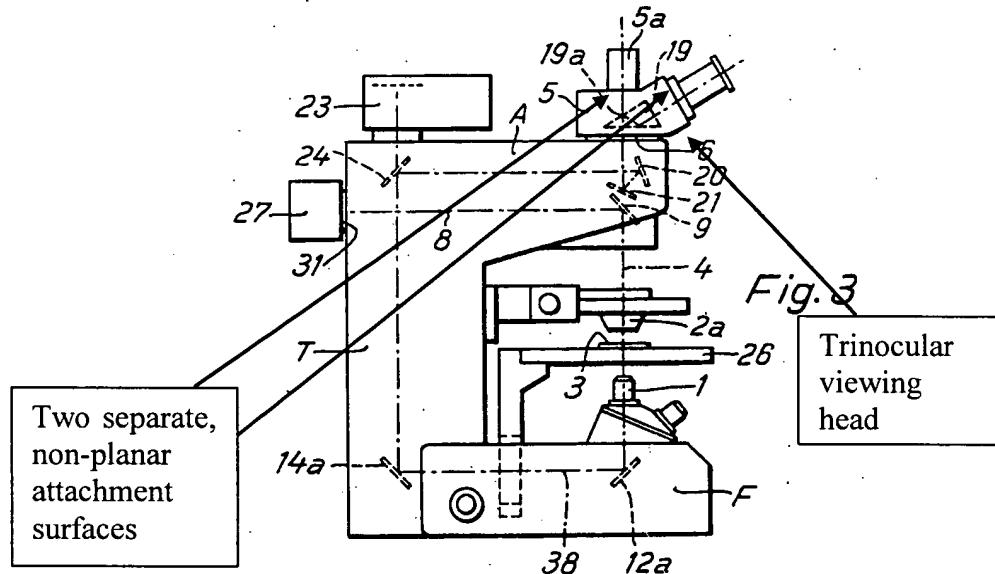
**The Rejection of Claims 1, 2, 5, and 12 Under 35 U.S.C. § 102**

The Examiner rejected Claims 1, 2, 5, and 12 under 35 U.S.C. § 102(b) as anticipated by United States Patent No. 4,619,503 (*Reinheimer et al.*). Applicants respectfully traverse this rejection and request reconsideration for the following reasons.

Applicants courteously submit that the device disclosed by *Reinheimer* does not include a module which is removably attached to a microscope housing, wherein the module includes a horizontal upper surface and mutually exclusive binocular and photo tubes attached to said horizontal upper surface, as recited in Applicants' amended Claim 1. Applicants respectfully assert that *Reinheimer* discloses embodiments of a microscope housing having a binocular viewing head attached to the housing (Fig. 2); a trinocular viewing head plus a camera attached to the housing (Fig. 3); and, a binocular viewing head plus a viewing screen attached the housing (Fig. 4). Thus, Applicants courteously submit that the removably attached module of the instant application is not the same as the embodiments taught by *Reinheimer*.

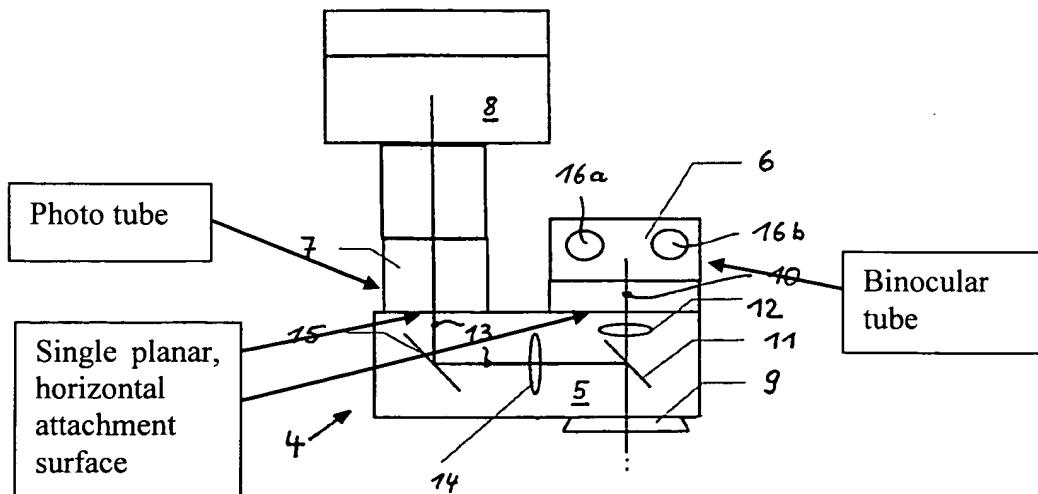
In the instant Office Action, the Examiner has asserted that *Reinheimer*'s module 5, shown Fig. 3, is analogous to Applicants' module (4). Applicants courteously submit that *Reinheimer* teaches a trinocular viewing head, *i.e.*, module 5 of Fig. 3, having eye tubes and a photo tube attached to two separate, non-planar surfaces of the trinocular viewing head. Thus, it generally follows that *Reinheimer* fails to teach a module having a horizontal upper surface for mounting mutually exclusive binocular and photo tubes thereon, as recited in Applicants' amended Claim 1. (See Figure below).

Attorney Docket No. LWEP:121US  
 U.S. Patent Application No. 10/735,394  
 Reply to Office Action of November 28, 2006  
 Date: February 28, 2007



*Reinheimer Fig. 3*

Contrarily, Applicants' amended Claim 1 recites a module (4) comprising a horizontally protruding base unit (5) having a horizontal upper surface and both a binocular tube (6) and a photo tube (7) individually attached to the horizontal upper surface, wherein the binocular tube (6) and photo tube (7) are mutually exclusive. (See Figure below).



*Applicants' Figure 1*

Attorney Docket No. LWEP:121US  
U.S. Patent Application No. 10/735,394  
Reply to Office Action of November 28, 2006  
Date: February 28, 2007

Unlike the embodiments described in *Reinheimer*, Applicants' amended Claim 1 recites an arrangement wherein the binocular and photo tubes are mutually exclusive, or in other words, side by side, thereby permitting a user of the instant invention to merely raise her head slightly from the binocular tubes to have a free and unimpeded view of the sample on the stage. This arrangement is particularly advantageous when using the instant invention as shown in Applicants' Figure 2.

"A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference." *Vandergaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). MPEP § 2131 (emphasis added). In addition, "Every element of the claimed invention must be literally present arranged as in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added).

Hence, as Applicants' amended Claim 1 contains at least one element that is not disclosed in *Reinheimer*, *i.e.*, a module comprising a horizontally protruding base unit having a horizontal upper surface and mutually exclusive binocular and photo tubes individually attached to the horizontal upper surface, it generally follows that *Reinheimer* does not anticipate Applicants' amended Claim 1. In like fashion, as Claims 2, 5 and 12 contain all the limitations of the claims from which they depend, *i.e.*, Claim 1, it follows that Claims 2, 5 and 12 are also not anticipated by *Reinheimer*.

Furthermore, as *Reinheimer* does not teach, suggest or motivate one to include the missing elements, *i.e.*, a module comprising a horizontally protruding base unit having a horizontal upper surface and mutually exclusive binocular and photo tubes individually attached to the horizontal upper surface, it follows that Claim 1 is nonobvious in view of *Reinheimer*. Again, due to their dependency from Claim 1, Claims 2, 5 and 12 are also nonobvious in view of *Reinheimer*.

Therefore, in view of the foregoing, Applicants respectfully assert that Claims 1, 2, 5 and 12 are in condition for allowance, which action is courteously requested.

Attorney Docket No. LWEP:121US  
U.S. Patent Application No. 10/735,394  
Reply to Office Action of November 28, 2006  
Date: February 28, 2007

The Rejection of Claims 3, 4, 6-11 and 13-48 Under 35 U.S.C. § 103

The Examiner rejected Claims 3, 4, 6-11, and 13-48 under 35 U.S.C. § 103(a) as being unpatentable over *Reinheimer*. Applicants respectfully traverse this rejection and request reconsideration for the reasons set forth above and the following reasons.

In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In addition, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

As set forth above, Applicants' amended Claim 1 is nonobvious in view of *Reinheimer*. Hence, due to their dependency from Claim 1, Claims 3, 4, 6-11 and 13-48 are also nonobvious in view of *Reinheimer*.

Therefore, in view of the foregoing, Applicants respectfully assert that Claims 3, 4, 6-11 and 13-48 are in condition for allowance, which action is courteously requested.

Claims 49-50

Applicants courteously submit that the instant Office Action is improper because the Examiner has not included Claims 49 and 50 in the statement of rejection. Although, Claims 49 and 50 are included in the body of the above described rejection under § 103(a), the statement of rejection is defective in failing to recite which claims are included in the rejection.

Regardless of the basis of rejection, Applicants courteously submit that as set forth above, Applicants' amended Claim 1 is nonobvious in view of *Reinheimer*, *i.e.*, the only reference relied upon in the instant Office Action. Dependent Claims 49 and 50 contain all of the limitations of independent Claim 1, due to their dependency therefrom. Thus, as Claim 1 is nonobvious in view of *Reinheimer* due to the missing elements, it necessarily follows that

Attorney Docket No. LWEPA:121US  
U.S. Patent Application No. 10/735,394  
Reply to Office Action of November 28, 2006  
Date: February 28, 2007

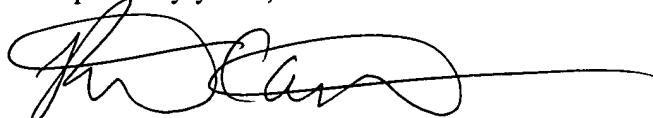
Claims 49 and 50 are also non-obvious in view of *Reinheimer*, due to their dependency from Claim 1.

Therefore, in view of the foregoing, Applicants respectfully assert that Claims 49 and 50 are in condition for allowance, which action is courteously requested.

**Conclusion**

Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned agent of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,



Robert C. Atkinson, Esq.  
Registration No. 57,584  
Simpson & Simpson, PLLC  
5555 Main Street  
Williamsville, NY 14221  
Phone: (716) 626-1564  
Fax: (716) 626-0366

Dated: February 28, 2007